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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,683	12/28/2000	Hyong-Taek Lim	0630-1193P	6561

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EXAMINER
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LAZARO, DAVID R

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 05/13/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

8

## Office Action Summary

Application No.

09/749,683

Applicant(s)

LIM ET AL.

Examiner

David Lazaro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 6-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a remote controller with a communications interface for transmitting/receiving device control information, classified in class 341, subclass 176.
  - II. Claim 6 and 7, drawn to a method for downloading control information through the Internet to a computer and transferring the control information to a remote controller for controlling a device, classified in class 709, subclass 218.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a remote control device with a communications interface that transmits/receives control information that originates from a source besides the Internet without utilizing the features of Invention I. Invention II has separate utility such as a method to download control information to a PC to be stored on any type of remote controller with an appropriate communications interface without utilizing the features of Invention II. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with James Eller (39,538) on 05/05/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Priority***

6. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. This application claims priority of Korea 2000-23989 filed 05/04/2000.

***Information Disclosure Statement***

7. The information disclosure statement (IDS) submitted on 04/21/03 has been considered by the examiner.

***Specification***

8. The abstract of the disclosure is objected to because the phrase "which has a large bulk and is hard to transfer" is not very clear. The phrase "which is bulky and hard to move" would be clearer. Correction is required. See MPEP § 608.01(b).
9. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

***Claim Objections***

10. Claims 1 and 4 are objected to because of the following informalities:
- a. Claim 1: The phrase "a control command or data from a control object to be controlled or the personal computer" would be clearer as "a control command or data to a control object to be controlled or from the personal computer".
  - b. Claim 4: "a operation" should be "an operation"
- Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. The term "the most appropriate" in claim 4 is a relative term which renders the claim indefinite. The term "the most appropriate control data" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. While the claim states "in accordance with a operation time or contents state of the apparatus to be controlled", the "operation time" or "contents state" are broadly stated and do not define an end result or specific functionality to be attained. Since there is no claimed subject matter as to an end result or specific functionality to be attained, the control data that is "most appropriate" cannot be determined. Therefore Claim 4 is indefinite.

14. Claims 4 and 5 each recite the limitation "the apparatus to be controlled". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

16. Claims 1-5 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S.

Patent 6,104,334 by Allport (Allport).

17. With respect to Claim 1, Allport teaches an internet remote controller (Col. 5 lines 50-58), comprising: a transmission/reception unit interfaced with a personal computer connected to the internet and having a data output device in order to transmit or receive data according to control of a control unit (Col. 27 lines 40-61 and Col. 28 lines 51-59); and the control unit for controlling to transmit/receive selectively a control command or data from a control object to be controlled or the personal computer according to operation of a switch (Col. 11 lines 6-16).

18. With respect to Claim 2, Allport teaches all the limitations of Claim 1 and further teaches the transmission/reception unit is constructed so as to be interfaced by an infrared transmission/reception method when the data output device of the personal computer is constructed as the infrared transmission method (Col. 28 lines 51-59).

19. With respect to Claim 3, Allport teaches all the limitations of Claim 1 and further teaches the transmission/reception unit is constructed so as to be interfaced by being inserted into an adapter when the data output unit of the personal computer is constructed as the adapter type (Col. 28 lines 51-59).

20. With respect to Claim 4, Allport teaches all the limitations of Claim 1 and further teaches the transmitted/received data is the most appropriate control data in

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accordance with a operation time or contents state of the apparatus to be controlled (Col. 5 line 50 – Col. 6 line 13).

21. With respect to Claim 5, Allport teaches all the limitations of claim 1 and further teaches the control unit switches the transmission/reception unit into a reception mode when it receives data from the personal computer connected to the internet, and it switches the transmission/reception unit into a transmission mode when it transmits data to the apparatus to be controlled (Col. 11 lines 6-16 and Col. 12 lines 6-16).

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

23. U.S. Patent 6,401,059 by Shen et al. "Method and system for using a personal digital assistant as a remote control." June 4, 2002.

24. U.S. Patent 5,778,256 by Darbee "PDA having a separate infrared generating device connected to its printer port for controlling home appliances" July 7, 1998.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 703-305-4868. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Lazaro  
May 11, 2004



**PATRICE WINDER**  
**PRIMARY EXAMINER**